

1                   **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
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3                   Date: September 18, 2008  
4

5                   In re application of:  
6

7                   **Kelkar et al**  
8

9                   Serial No.: 10/629,448  
10

11                  Filed: July 29, 2003  
12

13                  Group Art Unit: 1631  
14

15                  Examiner: Loria Clow  
16

17                  FOR: **Method and Program**  
18

19                  **Product for Discovering**  
20

21                  **Similar Gene Expression Profiles**  
22

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on: 18 SEP 2008 by: KARL D HESSE

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18 SEPTEMBER 2008

Date of Signature

16                   **REPLY BRIEF**  
17

18                  Assistant Commissioner for Patents  
19                  Washington DC 20231  
20

21                  Sir:  
22

23                  Appellants herewith submit a Reply Brief in support of the  
24                  appeal to the Board of Patent Appeals and Interferences from the  
25                  decision dated May 16, 2007 of the Primary Examiner finally  
26                  rejecting claims 1-6, 10-16 and 20, and from the Examiners  
27                  assertions contained in the Examiners Answer.  
28

1           **(B) Status of Claims**

2

3       Claims 1-6, 10-16 and 20 are pending in this application.

4

5       Claims 7-9 and 17-19 were canceled after restriction.

6

7       Issue I, The rejection of claims 1, 2, 4, 6, 12, 14, 16 and  
8       20 under 35 U.S.C. 112 has been withdrawn from appeal by the  
9       Examiner

10

11       Issue II, The rejection of claims 1-6, 10-16 and 20 under 35  
12       U.S.C. 101 is appealed.

1                   (C)    Grounds of Rejection to be reviewed on Appeal

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3                 Claims 1-6, 10-16 and 20 are pending in this application.

4

5                 The rejection of claims 1-6, 10-16 and 20 under 35  
6 U.S.C. 101 is appealed.

7

8                 The remaining issue in this appeal is:

9

10          II. Whether output to a user is a required claim step in order to  
11 define an invention, that is a practical application which is  
12 useful, concrete and tangible.

13

14          Claim 10 is representative of claims 1-6, 10-16 and 20 which  
15 have been rejected under 35 U.S.C. 101 and is related to Issue II.

16

17

1            **(D) Argument**

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3       **Issue II:** Whether output to a user is a required claim step in  
4       order to define an invention, that is a practical application  
5       which is useful, concrete and tangible.

6

7       Appellants claim in representative claim 10:

8       10. A program product having computer readable code stored on  
9       a recordable media for determining similarity between portions of  
10      gene expression profiles comprising:

11          programmed means for processing a number of gene expression  
12       profiles with a similar sequences algorithm that is a time and  
13       intensity invariant correlation function to obtain a data set of  
14       gene expression pairs and a match fraction for each pair; **Page**  
15       **7,Line 31-Page 8,Line 9 (Paragraph 36) and Fig. 1, # 213, 215**

16          programmed means for listing gene expression pairs in  
17       clusters by their match fractions; **Page 8 Lines 16-26 (paragraph**  
18       **38) and Fig.2 # 223**

19          programmed means for removing a first gene from a cluster  
20       when the first gene is also in another cluster which has another  
21       gene with a higher match fraction with the first gene than any of  
22       the genes in the cluster have with the first gene; **Page 8 Line 27-**  
23       **Page 9 Line 7 (paragraph 39) and Fig. 2 # 225**

24          programmed means for repeating the removing step until all  
25       genes are listed in only one cluster. **Page 8 Line 27-Page 9 Line 7**  
26       **(Paragraph 39) last sentence**

1 These remarks are in reply to the Examiners "Response to Argument"

2

3 **A.** The Examiner faults applicants' attorney for stating that:

4 "Applicants believe that the specification and claims indeed  
5 do describe a method and a program product that produce a result  
6 that has substantial and credible utility as required by MPEP 2107  
7 II and that the claims are limited to a narrow practical  
8 application in a computer related art." The Examiner asserts that  
9 the claims are rejected under MPEP 2106 and not 2107.

10

11 Applicants' attorney is pointing out via the criticized paragraph  
12 that the result provided by applicants' invention is not merely  
13 abstract but provides a real world result in the art of computers.  
14 Applicants are not arguing that the rejection is based on MPEP  
15 2107. It is believed that the rejection is based on 35 U.S.C.  
16 101.

17

18 However, the Examiner did quote the MPEP 2107 language, faulted  
19 above, in the first Office Action on page 4 last paragraph and  
20 applicants have not seen any indication of this quote being  
21 withdrawn by the Examiner. Accordingly applicants' mention of  
22 MPEP 2107 in the Third Amended Appeal Brief is not improper.

23

24 Applicants' entire continuing argument is addressed directly to  
25 the Examiners interpretation of the words useful, concrete and  
26 tangible which is the language of MPEP 2106.

27

28 The Examiner asserts that:

29 "As set forth in MPEP 2106 regarding patent subject matter  
30 eligibility, the claimed invention as a whole must be useful and  
31 accomplish a practical application. That is, it must produce a

1       ‘useful, concrete **and** tangible result’ (emphasis added) State  
2       Street Bank and Trust ...).”

3

4       Applicants’ attorney has not found such emphasis, which the  
5       Examiner adds, to have been added by any court and therefore  
6       objects to such interpretation of the quoted language.

7       Applicants’ requests for a citation to a court decision supporting  
8       the Examiners added emphasis has been ignored.

9

10      The Examiner, in the Examiners Answer, then goes on to mix “real  
11     world value” of Gottschalk v. Benson and “starting point for  
12     future research”, citing Brenner v. Manson, In re Fischer and In  
13     re Ziegler. It is believed that this assertion is also based on  
14     35 U.S.C. 101 and is believed to be without merit.

15

16      Applicants have not invented a genomic subsequence, an expressed  
17     sequence tag (EST) or a compound having value only in further  
18     research. Applicants have disclosed and claimed a computer method  
19     and article of manufacture that is fully complete and provides a  
20     result that is not abstract but is “useful, concrete and tangible”  
21     as required by Alappat and cases that follow Alappat. Accordingly  
22     the Examiners assertion is misplaced.

23

24      Regarding claims 10-16, the Examiner raises, for the first time in  
25     the Examiners Answer, an assertion that the claim limitation  
26     “stored on a recordable medium” reads on “carrier wave storage”  
27     allegedly described by applicants at page 7 and then cites In re  
28     Nuijten; CAFC 2006-1371. This is believed to be a continued  
29     rejection under 35 U.S.C. 101.

30

31      Page 7 of applicants’ specification does describe “These programs  
32     are contained in media 55 such as a diskette or compact disc or  
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1       they are part of a communication signal received at a modem or  
2       other communications connection version of media 55.”  
3       Applicants’ specification does not say “carrier wave storage”  
4       which is a novel creation of the Examiner and not contemplated by  
5       applicants. One stores programs in a memory which may be solid  
6       state circuits, optical or magnetic discs. Programs may be  
7       transmitted to a memory in a computer by a communications  
8       connection as applicants’ specification states but “carrier wave  
9       storage” is not real world and is not being claimed by applicant.

10  
11      Since applicants’ claims recite “**stored on a recordable media**”  
12      which is not mentioned or decided by Nuijten, it is believed that  
13      this belated assertion is without merit.

14  
15      **B.** The Examiner is not persuaded by applicants’ recitation of  
16      MPEP 1206 and Gottschalk v. Benson and Warmerdam. However the  
17      Examiner still has not cited any court decision supporting the  
18      bold emphasis of the word **and** in “useful, concrete and tangible”  
19      as it is interpreted by the Examiner to be a multi-prong test.  
20      Accordingly the Examiners interpretation of the MPEP does not  
21      appear to be based on current law.

22  
23      **C.** The Examiner is not persuaded by the evidence provided in U.S.  
24      Patents 6,406,853 and 6,436,642 of the usefulness of methods for  
25      finding similar gene expression profiles. The Examiner asserts  
26      that the claims of 6,406,853 comprise physical transformation.

27  
28      The merits of these patents may not be relevant to applicants'  
29      invention but the relevant law clearly should be uniformly applied  
30      to all inventions.

1 These patents were not cited to compare their claim language with  
2 applicants' claim language but to show the non abstract nature of  
3 applicants' invention as claimed. However the claims of  
4 6,436,642, not mentioned by the Examiner, are interesting in that  
5 they describe no output to a user and no physical transformation.  
6 However the subject matter being claimed in U.S. 6,436,642 is  
7 clearly useful and not abstract.

8

9 Applicants again question whether the Examiner has complied with  
10 MPEP 2106 II by "determining what applicants have invented and are  
11 seeking to patent" by a complete examination including a search of  
12 the prior art.

13

14 All of the prior art of record in this application has been cited  
15 by applicants.

16

17 Evidence of this lack of a complete examination by the Examiner  
18 appears in:

19 the belated need by the Examiner to withdraw the rejection  
20 under 35 USC 112, 2nd paragraph;

21 the belated new assertion regarding "starting point for  
22 future research", citing Brenner v. Manson, In re Fischer and In  
23 re Ziegler, and finally;

24 the belated new assertion that applicants' claims read on  
25 "carrier wave storage" which is a novel creation of the Examiner  
26 and not contemplated by applicants nor is it described in  
27 applicants' specification regardless of the Examiners assertion.

28

29 It is believed that an early thorough reading of applicants'  
30 specification and a search of the prior art would have removed  
31 these new assertions and the 112 rejection and would have allowed  
32 the Examiner to reach the merits of applicants' invention.

